

## **REMARKS**

### **APPLICATION STATUS**

No claims have been canceled and claims 21-34 have been added. Accordingly, claims 1-34 are pending in the present application. No new matter has been introduced by way of the present amendment.

### **ALLOWABLE SUBJECT MATTER**

The indication in the Office Action, that claims 2-7, 11-13, and 17 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, is noted with appreciation. These claims have not been so rewritten at this time, as Applicants believe the independent claims from which they depend are in condition for allowance.

### **DRAWINGS**

The Office again fails to indicate whether the Examiner accepts the drawings as originally filed. Such an indication was respectfully requested in response to the Office Action of January 13, 2003, which also failed to indicate whether the drawings were acceptable. In the absence of an indication to the contrary, Applicants will consider the drawings acceptable to the Office.

### **CLAIM OBJECTIONS**

Claims 15 and 17 are objected to as being informal because the limitation "the openings" in each of the claims lacks antecedent basis. The claims have been amended to overcome the

objection. Accordingly, it is respectfully requested that the objection to claims 15 and 17 be reconsidered and withdrawn.

### 35 USC § 102 REJECTIONS

**Claims 1, 9, and 9 are allowable over US 5,476,142 to Sparlin et al.**

The rejection of claims 1-9 under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,476,143 to Sparlin *et al.* (hereinafter referred to as “the Sparlin patent”) is respectfully traversed for the reasons set forth hereinafter.

Claim 1, as amended, recites:

*A completion assembly deployed within a well bore, comprising:  
a base pipe having a sidewall with at least one hole through the sidewall;  
a filter surrounding at least a portion of the base pipe;  
a plurality of splines located between the base pipe and the filter; and  
a rod selectively insertable between adjacent splines, selectively covering  
the at least one hole. [Emphasis added]*

The Office Action alleges that the Sparlin patent “discloses a well screen that includes a base pipe 2 having at least one hole 2a, a filter 5, a plurality of splines 6, and a rod 3.”<sup>1</sup> The Office Action further alleges that “the rods [are] adjustably placed.”<sup>2</sup> Applicants respectfully submit that whether the rods are adjustably placed is moot, as claim 1 requires that the rod be “selectively insertable between adjacent splines.” For the Sparlin patent to anticipate the claimed invention, using the Office’s construction of the Sparlin patent, the rod 3 must be selectively insertable between adjacent tubes 6, selectively covering at least one perforation 2a. The Sparlin patent, however, fails to teach that the rods 3 are selectively insertable but merely discloses that they are “disposed cylindrically at a predetermined interval in the circumferential direction of the

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<sup>1</sup> See page 2, lines 16-17, of the present Office Action.

<sup>2</sup> See page 2, line 18, of the present Office Action.

screen 1 and a wire 5.”<sup>3</sup> Further, the Sparlin patent teaches that “[t]he support rods 3 are disposed in a position where they do not interfere with the perforations 2a of the pipe 2.”<sup>4</sup> Claim 1 requires that the rod is “selectively insertable between adjacent splines, **selectively covering the at least one hole.**” Thus, the Sparlin patent teaches a rod 3 that is structurally different than the claimed invention, in that the Sparlin rod 3 does not interfere with the perforation 2a, while the claimed rod selectively covers the at least one hole.

An anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim.<sup>5</sup> Further, “[t]he identical invention must be shown in as complete detail as is contained in the...claim.”<sup>6</sup> The Sparlin patent, however, fails to meet these standards. For at least these reasons, the Sparlin patent fails to anticipate the present invention, as set forth in claim 1.

Further, the Sparlin patent cannot render the present invention, as set forth in claim 1, obvious. The Sparlin patent teaches away from the claimed invention, in that the Sparlin rod 3 does not interfere with the perforation 2a, while the claimed rod selectively covers the at least one hole. There can be no motivation or suggestion to combine references as a matter of law where one of the references teaches away from the claimed invention.<sup>7</sup> Rather, teaching away is *prima facie* evidence of nonobviousness.

Claims 8 and 9 depend from claim 1. Accordingly, the remarks provided above apply equally to claims 8 and 9.

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<sup>3</sup> See column 4, lines 41-43, of the Sparlin patent.

<sup>4</sup> See column 4, lines 50-51, of the Sparlin patent.

<sup>5</sup> See *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

<sup>6</sup> See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

<sup>7</sup> See *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984).

Therefore, it is respectfully requested that the rejection of claims 1, 8, and 9 under 35 USC § 102(b), as being anticipated by the Sparlin patent, be reconsidered and withdrawn.

**Claims 10, 14-16, and 18-20 are allowable over US 5,394,938 to Cornette *et al.***

The rejection of claims 10, 14-16, and 18-20 under 35 USC § 102(b), as being anticipated by U.S. Patent No. 5,394,938 to Cornette *et al.* (hereinafter referred to as “the Cornette patent”), is respectfully traversed for the reasons set forth hereinafter.

Each of claims 10 and 20, as amended, require that “rotation of the sleeve relative to the base pipe aligns or misaligns the holes and the at least one opening, such that the completion assembly is adapted to vary fluid communication between the well bore and the central cavity.”<sup>8</sup> The Office Action alleges that the base pipe 40 and the screen jacket 41 of the Cornette patent are the claimed base pipe and sleeve, respectively. The Cornette patent, however, fails to disclose or suggest that the completion assembly 26 is adapted to vary fluid communication between the well bore and the central cavity of the base pipe 40, as required by claims 10 and 20. The Cornette patent illustrates the openings through the base pipe 40 to be generally the same size and regularly spaced and the openings through the screen jacket 41 to be generally the same size and regularly spaced.<sup>9</sup> Accordingly, Applicants maintain that rotating the screen sleeve 41 with respect to the base pipe 40 would not vary the fluid communication between the well bore and the central cavity, as required by claims 10 and 20. Thus, the Cornette patent teaches a well tool 17 that is structurally different than the claimed invention, in that the Cornette well tool 17 is not adapted to vary fluid communication between the well bore and the central cavity of the base

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<sup>8</sup> See lines 6-10 of claim 10 and claim 20.

<sup>9</sup> See Figure 2 of the Cornette patent.

pipe 40. For at least these reasons, the present invention, as set forth in claims 10 and 20, are allowable over the Cornette patent.

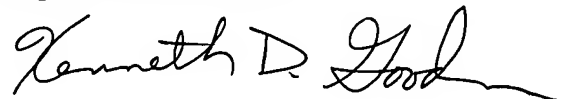
Claims 14-16, 18, and 19 depend from claim 10. Therefore, the remarks provided above concerning claim 10 apply equally to claims 14-16, 18, and 19.

Accordingly, it is respectfully requested that the rejection of claims 10, 14-16, and 18-20 under 35 USC § 102(b), as being anticipated by the Cornette patent, be reconsidered and withdrawn.

### CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to contact Daren C. Davis at (817) 578-8616 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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